Docket No.: 072280-0013 **PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of | : | Customer Number: 20277 |
| Munekatsu SHIMADA, et al. | : | Confirmation Number: 9266 |
| Application No.: 10/572,855 | : | Group Art Unit: 2834 |
| Filed: March 22, 2006 | : | Examiner: KIM, John K. |

For: ROTOR USING ELECTRICAL STEEL SHEET WITH LOW IRON LOSS, ROTOR MANUFACTURING METHOD, LASER PEENING METHOD, AND LASER PEENING APPARATUS

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Noting the Office Action of June 9, 2008 wherein restriction has been required, Applicants hereby elect Group I, claims 1-5 readable thereon, with traverse for prosecution in the above-identified application.

The Restriction Requirement is improper because this application was filed under 35 U.S.C. § 371. To properly restrict a 371 application, the Examiner must apply the Unity of Invention standard. Though the Examiner alleged the groups lacked Unity of Invention and cited PCT Rule 13.1, the Examiner applied a U.S. restriction practice analysis in asserting that the claims lack unity of invention. As explained in the MPEP § 1893.03(d):

> When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group. . . .
>
> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one

> common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. . . .
>
> A process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product with the technical relationship being present between the claimed process and the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process.
>
> An apparatus or means is specifically designed for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship being present between the claimed apparatus or means and the claimed process. The expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor does it imply that the process could not be carried out using an alternative apparatus or means.

The Examiner alleged that Group I is directed to an apparatus, Group II is directed to a process for manufacturing the apparatus, Group III is directed to an other apparatus, and Group IV is directed to a method a using the other apparatus. The Examiner has not shown the Groups lack a **single general inventive concept** where there is a technical relationship among the inventions **that involves at least one common or corresponding special technical feature,** as required when imposing a restriction in an application filed under 35 U.S.C. § 371.

The Examiner further asserted, "[t]he interior permanent magnet rotor and laser irradiator can be distinct invention. The laser irradiator can be operated by any other type of actuator instead of interior permanent magnet rotor, and furthermore in some cases, it can be operated without actuator" (emphasis added). However, whether the claims can be distinct and whether an apparatus can be operated in a different manner is not relevant in a restriction requirement under the Unity of Invention standard.

Because the Examiner did not properly apply the Unity of Invention standard in Restriction Requirement the restriction is improper. In view of the improper Restriction

Requirement, Applicants respectfully request that all the claims (1-35) should be examined on the merits.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Bernard P. Codd
Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:kap
Facsimile: 202.756.8087
**Date: July 9, 2008**

**Please recognize our Customer No. 20277 as our correspondence address.**